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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TO, BAOQUOC N

ART UNIT PAPER NUMBER

2162

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/552,131	MELKOTE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Baoquoc N. To	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claim 37 is amended in the amendment filed on 10/27/2005. claims 1-41 are pending in this application.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 17, 23 and 37 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. Claim 21 is objected to because of the following informalities: CAD is not defining, CAD file is just a file. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 8-10, 12-14, 16-21, 37 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (US. Patent 6,434,580 B1).

As to claim 1, Takano a method of forming an invention disclosure comprises the step of:

Forming an invention disclosure online by entering a plurality of selected information portions into a web-based system (a storage medium recording thereon a program for preparing patent specifications with inventors and persons in charge filing patent applications using a plurality of computer connected to a communication network, such as internet, for preparing patent specifications for patent applications) (col. 1, lines 13-18 and col. 5, lines 55-61).

After each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (after the inventor prepared the draft data on a specification, the data is transmits to and stored the server computer 300 in order to allow the client computer 200 to download for revision and filing with the patent office) (col. 6, lines 1-23); and

Allowing access to various users for reviewing the information (patent-application-filling person can download the draft for revision (col. 6, lines 5-19) and the inventor can download the revision to check before submitting to the Patent office (13, lines 12-15).

As to claim 2, Takano teaches a method recited in claim 1 wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (the inventor can access the upload file by login using password) (col. 9, lines 59-61).

As to claim 8, Takano teaches a method as recited in claim 3 further comprising the step of notifying a patent staff in response to the classification information (the

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patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16)..

As to claim 9, Takano teaches a method as recited in claim 8 further comprising the step of prompting a patentability review from the patent staff person (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16).

As to claim 10, Takano teaches a method as recited in claim 1 wherein said central location comprises a database coupled to a web server (memory unit 310) (col. 1, lines 48-49).

As to claim 12, Takano teaches a method recited in claim 11 wherein said step of notifying comprises the step of generating an E-mail having a hyperlink therein.

As to claim 13, Takano teaches a method as recited in claim 11 further comprising the step of viewing the status of the invention disclosure on-line (the inventor can log in and check if any corrections are required) (col. 9, lines 59-62).

As to claim 14, Takano teaches a method recited in claim 1 further comprising the step of providing a status update via E-mail (notification notify the draft have been upload for viewing by the patent-application-filing person or inventor) (col. 12, lines 8-20).

As to claim 16, Takano teaches a method as recited in claim 1 further comprising the step of accepting a paper submission (convention system); and wherein the step of forming comprises scanning said paper submission into the database (conventional system) (col. 1, lines 45-48).

Claim 17 is rejected under the same reason to claim 1.

Claim 18 is rejected under the same reason to claim 2.

As to claim 19, Takano teaches a system as recited in claim 17 wherein said server comprises a web server (Internet) (col. 1, lines 13-15).

As to claim 20, Takano teaches a system as recited in claim 17 wherein said user computer comprises a web browser for accessing said server (access before downloading) (col. 6, lines 5-15).

As to claim 21, Takano teaches a system as recited in claim 18 wherein said user computer comprises a CAD file viewer coupled to said web browser (internet) (col. 1, lines 13-17).

As to claim 37, Takano teaches a method of submitting documents comprising:

Entering identification information into a user computer (the inventor enter password and user name from the user computer to gain access to the server 300) (col. 9, lines 59-63)

Retrieving user information from a directory system in response to said identification information (the user can retrieve the name of the registered invention in the server) (col. 7, lines 64-67 and col. 8, lines 6);

Entering disclosure information to create an invention disclosure (the inventor can check the revision and make changes to the revision draft and submit to server 300) (col. 10, lines 8-15);

Coupling said user information with said invention disclosure (each time the report containing inventor information and the draft are upload to the server 300) (col. 10, lines 15-30); and

Storing the disclosure in a computer database (the draft copy of the invention is upload into the server 300) (col. 6, lines 1-4)

Claim 40 is rejected under the same reason as to claim 8.

Claims 41 is rejected under the same reason as to claim 9.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4, 23-24, 28-30, 33-34, 36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (US. Patent No. 6,434,580 B1) in view of Barney et al. (US. Patent No. 6,556,992 B1).

As to claim 23, Takano teaches a method of forming an invention disclosure comprising:

forming an invention disclosure online by entering a plurality of selected information portions into a web-based system (a storage medium recording thereon a program for preparing patent specifications with inventors and persons in charge filing patent applications using a plurality of computer connected to a communication

network, such as internet, for preparing patent specifications for patent applications) (col. 1, lines 13-18 and col. 5, lines 55-61).

After each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (after the inventor prepared the draft data on a specification, the data is transmits to and stored the server computer 300 in order to allow the client computer 200 to download for revision and filing with the patent office) (col. 6, lines 1-23); and

Allowing access to various users for reviewing the information (patent-application-filling person can download the draft for revision (col. 6, lines 5-19) and the inventor can download the revision to check before submitting to the Patent office (13, lines 12-15).

notifying an evaluator in response to the classification information (notifying the patent-application-filling persons) (col. 12, line 9-13); and

prompting an evaluation from the evaluator (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16).

Takano does not explicitly teach prompting the user for classification information. However, Takano teaches prompting for the user for prior searching (col. 14, lines 9-17). On the other hand, Barney discloses prompting the user for classification information (col. 36, lines 41-44). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano's system



to include classification information as taught by Barney in order patent application to arrive to the right patent staff for review.

As to claim 24, Takano teaches a method recited in claim 23 wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (col. 7, lines 64-67 and col. 8, lines 1-6).

As to claim 28, Takano teaches a method recited in claim 23 further comprising the step of notifying a patent staff person in response to the classification information (the notification means 108 notifies, by electronic mail, notifying the patent-application-filing persons using the client computer 200) (col. 12, lines 8-10).

As to claim 29, Takano teaches a method as recited in claim 23 further comprising the step of prompting a patentability review from the patent staff person (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16).

As to claim 30, Takano teaches a method as recited in claim 23 wherein said central location comprises a database coupled to a web server (memory unit 310) (col. 5, lines 48-49).

As to claim 33, Takano teaches a method as recited in claim 23 further comprising the step of viewing the status of the invention disclosure on-line (the inventor log-in to the server 300 to check if the applicant is done or need additional corrections) (col. 9, lines 59-62).

As to claim 34, Takano teaches a method as recited in claim 23 further comprising the step of viewing the status of the invention disclosure update via E-mail (the inventor receive the email to review the revision of draft by e-mail) (col. 12, lines 8-13)

Claim 36 is rejected under the same reason as to claim 16.

Claim 3 is rejected under the same reason as to claim 23.

As to claim 4, Takano teaches a method as recited in claim 3 further comprising the steps of notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16).

Claim 38 is rejected under the same reason as to claim 23.

Claim 39 is rejected under the same reason as to claim 4.

6. Claims 11, 15, 22, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (US. Patent No. 6,434,580 B1) in view of Barney et al. (US. Patent No. 6,556,992 B1) and further in view of Balijepalli et al. (Pub. No. US 2004/0230566 A1).

As to claim 31, Takano and Barney do not explicitly teach identifying co-authors; notifying co-authors of a disclosure with their name associated with therewith in the system. Balijepalli discloses in fig. 5 with the template taking the user information including user name and password for accessing the system, and email addresses for notification system. This template is also used to registering inventor and co-inventor

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and their e-mail addresses for notification purposes. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Barney system to include Balijepalli system in order to notify both inventor and co-inventor as taught by Balijepalli in order to notify the applicants about the status of their application.

Claim 11 is rejected same reason as to claim 31.

As to claim 22, Takano and Barney do not explicitly teach said server comprises a web single login. On the other hand, Balijepalli discloses two fields to enter user name and password for accessing the server system (fig. 1). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Barney system to include user name and password to gain access to the server as taught by Balijepalli in order to provide authorize user to access the system.

Claim 15 is rejected under same reason as to claim 22.

Claim 35 is rejected under the same reason as to claim 22.

7. Claims 5, 12, 25 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (US. Patent No. 6,434,580 B1) in view of Barney et al. (US. Patent No. 6,556,992 B1) and further in view of Todd, Sr. et al. (US. Patent No. 6,185,689 B1).

As to claim 25, Takano and Barney do not explicitly teach notifying an evaluator comprises the step of generating an E-mail; providing a hyperlink to the disclosure in the E-mail. However, Takano teaches notifying an evaluator comprising an E-mail (col.

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12, lines 8-12). On the other hand, Todd discloses the hyperlink to the disclosure in the E-mail (col. 7, lines 61-65). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Barney system to include hyperlink to link to the file in the e-mail as taught by Todd in order to provide the conveniences by accessing the file without requiring user name and password.

Claim 5 is rejected under the same reason as to claim 25.

Claim 12 is rejected under the same reason as to claim 25.

Claim 32 is rejected under the same reason as to claim 25.

8. Claims 6-7 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (US. Patent No. 6,434,580 B1) in view of Barney et al. (US. Patent No. 6,556,992 B1) and further in view of Forrest et al. (US. Patent No. 5,276,869).

As to claim 26, Takano teaches a method recited in claim 23, however Takano and Barney do not explicitly teach the step of prompting an evaluation comprises scheduling an evaluation meeting. On the other hand, Forrest teaches scheduling an evaluation meeting (col. 9, lines 5-13). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify both Takano and Barney system to include scheduling a meeting include evaluation or voting as taught by Forrest in order to allow the inventor to explain their invention.

Claim 6 is rejected under the same reason as to claim 26.

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As to claim 7, Takano and Barney do not explicitly teach the step of prompting an evaluation comprises ranking the disclosure. However, Forrest disclose evaluation ranking the disclosure (col. 8, lines 15-18). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Barney to include weighting the disclosure of invention as taught by Forrest in order to determine if it is a good invention to submit into the patent office.

Claim 27 is rejected under the same reason as to claim 7.

**Contact Information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is at 571-272-4041 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at 571-272-4107.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231.

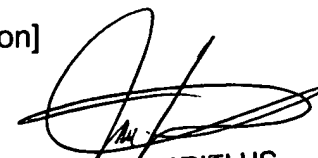
The fax numbers for the organization where this application or proceeding is assigned are as follow:

(571) –273-8300

[Official Communication]

BQ To

January 8th, 2006

  
JEAN M. CORRIELUS  
PATENT EXAMINER